

Application No. 10/654,508

Reply to Office Action

*REMARKS**Summary of the Application*

Claims 1-10 are currently pending in the application.

*Summary of the Office Action*

The Office Action dated November 10, 2005, opens by rejecting claim 1 under 35 U.S.C. § 112, second paragraph, because the claim does not clearly define  $R_a$ ,  $R_b$ ,  $R_c$ ,  $R_d$ ,  $R_e$  and  $R_f$ .

Claims 1-10 are rejected under the judicially-created doctrine of double patenting as being unpatentable over claims 1, 3, 5, 6 and 7 of U.S. Published Patent Application 2003/0091932A1. The claims are said to be not patentably distinct from one another "because the claims include a lithographic printing plate comprising a support with a hydrophilic surface, a coating with an oleophilic layer and an alkaline developer and an IR compound meeting all of the limitations of the chemical formula included in claim 1 of the instant application."

Claims 1-6 also rejected under the judicially-created doctrine of double patenting as being unpatentable over claims 1-5 of U.S. Published Patent Application 2003/0068578A1. The claims are said to be not patentably distinct from one another "because the reference includes a lithographic printing plate comprising a support with a hydrophilic surface, a coating with an oleophilic layer and an alkaline developer and an IR compound meeting all of the limitations of the chemical formula included in claim 1 of the instant application."

Finally, claims 1-10 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,238,838 to Gaschler et al. ("Gaschler").

*Discussion*

Reconsideration of the pending application is respectfully requested in view of the foregoing amendments and the following remarks.

At the outset, Applicants respectfully traverse the Section 112 rejection of claim 1. Claim 1 includes explicit definitions of  $R_a$ ,  $R_b$ ,  $R_c$ ,  $R_d$ ,  $R_e$  and  $R_f$ , as follows: " $R_a$ ,  $R_b$  and  $R_c$  being an optionally substituted alkyl, alkenyl, aryl or aralkyl group;  $R_d$ ,  $R_e$ , and  $R_f$  being hydrogen or an optionally substituted alkyl, alkenyl, aryl or aralkyl group." These functional groups are well-known to those skilled in the art, and those reading the claims would be able to determine the scope of claim 1 without difficulty. As claim 1 meets the requirements of Section 112, second paragraph, withdrawal of the rejection is respectfully requested.

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Turning to the first double patenting rejection, Applicants submit that the claims of the '932 application do not render claims 1, 3 and 5-7 unpatentable.

In determining whether a nonstatutory basis exists for a double patenting rejection, the question to be asked is—does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the cited patent (or patent application)? When conducting this analysis, the disclosure of the cited patent (or patent application) may not be used as prior art.

The question may be answered by conducting factual inquiries to determine: (1) the scope and content of the cited patent (or patent application) claim and the prior art relative to the claim in issue; (2) the differences between the scope and content of the cited patent claim and the prior art as determined in (1) and the claim in the application in issue; (3) the level of ordinary skill in the pertinent art; and (4) any objective indicia of nonobviousness. *See MPEP 804.II.B.1.*

There are several differences between the cited '932 application and the pending claims.

The polymer in the coating of the '932 application is alkali soluble and comprises a chromophoric moiety having a light absorption maximum between 400 and 780 nm and having a structure according to any of formula I to VI. In contrast, the claimed coating comprises an alkali soluble polymer and an IR-absorbing compound according to a specified formula, having a specified number of specific solubilizing groups (i.e., 3, 4 or 5 anionic groups or groups which become anionic in an aqueous alkaline solution of  $\text{pH} \geq 9$ ) and having several substituting groups (where none of such groups is a polymer).

The structure of the IR compound of the present invention is completely different relative to the chromophoric moieties of formula I to VI, is not bonded to the polymer, and has 3, 4 or 5 anionic solubilizing groups. None of these features are disclosed in the '932 application.

The aforementioned differences are not merely obvious variants of the cited subject matter of the '932 application. There is no teaching of the claimed subject matter in the '932 application. If this application provides any teaching at all, it teaches the use of a contrasting dye that is covalently bonded to the alkali-soluble polymer. Moreover, the IR-compounds claimed in the pending application are different from the compounds claimed in the '932 application; the more specific examples of the chromophoric moieties disclosed in claims 3 and 5-7 of the '932 application clearly emphasize this distinction.

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For these reasons, Applicants respectfully request withdrawal of this double patenting rejection.

Applicants submit that the claims 1-6, also rejected under the judicially-created doctrine of double patenting as being unpatentable over claims 1-5 of U.S. Published Patent Application 2003/0068578A1, are patentable thereover.

There are several differences between the pending claims and the claims of the '578 application. The claims of the '578 application describe an organic dye in an amount sufficient to provide a visible color to the coating and which does not reduce the dissolution rate of the unexposed areas in the developer. In contrast, the claimed invention includes a coating comprising an IR-absorbing compound according to a specific formula, wherein the formula has a certain number of specific solubilizing groups. Further, the organic dye in the '578 application is a visible dye used as a colorant; there is no disclosure or suggestion therein to use an IR compound as described in the pending claims. Claims 2-5 of the '578 application emphasize the clear distinction noted above by describing the organic dye in a manner that distinguishes the dye from the IR-absorbing compound used in the claimed invention.

For these reasons, Applicants respectfully request withdrawal of this double patenting rejection.

Finally, claims 1-10 are rejected as anticipated by Gaschler. An examination of the IR-compound described in Gaschler (*see, e.g., col. 2, lines 25-60*) does not meet all the limitations for the substituting groups and atoms as required by claims 1-10 of the present invention. For example, the Group Z<sup>3</sup> in claim 1 of the pending application is not disclosed in Formula 1 of Gaschler—only hydrogen atoms are present in the methane groups of the IR-compound of formula 1.

For at least this reason, Applicants respectfully request withdrawal of the anticipation rejection of claims 1-10 based on Gaschler.

#### *Conclusion*

As Applicants believe the application is in proper condition for allowance, the Examiner is respectfully requested to pass the application to issue. If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

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Respectfully submitted,



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